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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Arguments

Applicant's arguments filed 11/4/08 have been fully considered but they are not persuasive. The rejection of claims 1-19 based on Heublein *et al.* (US 2002/0004060) and Stinson *et al.* (US 6,340,367) (US 2004/0241036) is maintained for reason of record and following response.

Heublein *et al.* (US '060) discloses biodegradable implants {stents} (§ 2, 11, 30) comprising 50-98% magnesium, less than 5% of other metals or rare earths such as gold {radiopaque}, as well as trace amounts of other additions (§ 14-16, 30).

Stinson *et al.* (US '367) discloses implantable radiopaque markers {radiopaque stents} (1:5-8), wherein the amount of radiopaque element is added at various loading percentages approaching the threshold above which the loading causes unsatisfactory results (3:60-4:7), wherein the thickness of the radiopaque material is about 20 microns to 500 microns (4:27-56). The radiopaque material may disperse into the body when in vivo (5:49-62). Stinson *et al.* (US '367) clearly discloses that the marker can be anchored to an endoprosthesis {stent}, thereby preventing the marker from releasing from the implantable endoprosthesis {corresponding to a permanent radiopaque marker} (6:5-24).

Stinson *et al.* (US '367) discloses a radiopaque marker having a thickness of about 20 microns to about 500 microns (4:27-56; 16:8-16). The weight of the coating could be calculated via the volume of the coating and density of the marker. Additionally, Stinson *et al.* (US '367) discloses biosorbable markers in application 08/904,951 {corresponding to Stinson (US 6,174,330)}, wherein a coating thickness of about 20 microns to 500 microns of radiopaque

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material corresponds to about 1 wt% to about 80 wt% of radiopaque material [Stinson (US '330); 6:18-34].

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that Heublein *et al.* (US '060) and/or Stinson *et al.* (US '367) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Heublein *et al.* (US '060) and Stinson *et al.* (US '367) are analogous art because they are concerned with a similar technical difficulty, namely the preparation of implantable radiopaque marker. Heublein *et al.* (US '060) discloses biodegradable implants {stents} (§ 2, 11, 30) comprising less than 5% of metals or rare earths such as gold {radiopaque}. Stinson *et al.* (US '367) discloses implantable radiopaque marker {radiopaque stent} (1:5-8), wherein the radiopaque material may disperse into the body when in vivo (5:49-62).

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PEPITONE whose telephone number is (571)270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

MFP
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